

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Case No. 14-1208

DIGITAL CBT LLC

Plaintiff-Appellant,

v.

AT&T SERVICES, INC.

Defendant-Appellee.

**UNOPPOSED MOTION FOR STAY OF APPEAL PENDING ENTRY OF
FINAL JUDGMENT**

Plaintiff-Appellant, Digital CBT, LLC, respectfully moves and requests—without opposition—that this appeal (including the cross-appeal of AT&T Services, Inc.) be stayed pending entry of a final judgment by the United States District Court for the Central District of California in Case No. 2:12-cv-06421-CJC-JPR (the “Underlying Case”). The grounds for this motion are as follows:

On December 3, 2013, the District Court issued an Order (1) granting AT&T’s motion for partial summary judgment of non-infringement as to all claims of the asserted ’173 Patent and denying Digital CBT’s cross-motion for summary judgment of infringement; and (2) holding that to the extent AT&T’s counterclaim seeks a declaration of invalidity and unenforceability of the ’173 Patent, it is moot.

On December 31, 2013, Digital CBT filed a precautionary notice of appeal of the December 3, 2013 Order. On January 14, 2014, AT&T filed a precautionary notice of cross-appeal of the December 3, 2013 Order.

Although they have filed precautionary notices of appeal, the parties believe that there is not yet a final judgment in the Underlying Case, because the December 3, 2013 Order did not resolve multiple counterclaims and affirmative defenses. The District Court did not make an order in accordance with Federal Rule of Civil Procedure 54(b) (“the court may direct entry of a final judgment as to one or more, but fewer than all, claims . . . only if the court expressly determines that there is no just reason for delay.”). (In addition, the District Court did not

make a judgment in a “separate document” from its summary judgment order, as required by Federal Rule of Civil Procedure 58(a).)

On March 7, 2014, Digital CBT and AT&T submitted to the District Court a Stipulation for Entry of Final Judgment (Exhibit A) and a proposed Stipulated Final Judgment (Exhibit B) adjudicating all of the parties, claims, counterclaims, and affirmative defenses. Entry of the Stipulated Judgment by the District Court will result in a final judgment positioning this case for appeal.

Staying Digital CBT’s present appeal and AT&T’s present cross-appeal will promote judicial efficiency and avoid burdening this Court and the parties with redundant or futile proceedings conducted prior to entry of a final judgment.

The undersigned counsel for Digital CBT has discussed this motion with counsel for the other party to this appeal, Defendant-Appellee-Cross-Appellant AT&T Services, Inc., and has shown AT&T’s counsel drafts of this motion.

AT&T’s counsel have confirmed that they do not oppose this motion and will not be filing a response to it.

///

///

For the foregoing reasons, Digital CBT respectfully requests that this Court order that Digital CBT's appeal and AT&T's cross-appeal be stayed pending entry of the stipulated final judgment or any other final judgment by the District Court.

Dated: March 7, 2014

Respectfully submitted,

/s/William J. O'Brien

William J. O'Brien
One LLP
9301 Wilshire Boulevard
Beverly Hills, CA 90210
Tel. (310) 866-5158
Fax (310) 943-2085

wobrien@onellp.com
Attorneys for Plaintiff-Appellant
Digital CBT LLC

EXHIBIT A

1 Peter R. Afrasiabi (Bar No. 19336)
2 pafrasiabi@onellp.com
3 Nathaniel L. Dilger (Bar No. 196203)
4 ndilger@onellp.com
5 William J. O'Brien (Bar No. 99526)
6 wobrien@onellp.com
7 **ONE LLP**
8 4000 MacArthur Blvd.
9 East Tower, Suite 500
10 Newport Beach, California 92660
11 Telephone: (949) 502-2860
12 Facsimile: (949) 258-5081

13 Attorneys for Plaintiff and Counter-Defendant,
14 Digital CBT LLC

15 Timothy S. Durst (*admitted pro hac vice*)
16 Samir A. Bhavsar (*admitted pro hac vice*)
17 **BAKER BOTTS L.L.P.**
18 2001 Ross Avenue, Suite 800
19 Dallas, TX 75201-2980
20 Telephone: 214.953.6500
21 Facsimile: 214.953.6600

22 Attorneys for Defendant and Counterclaimant
23 AT&T SERVICES, INC.

24
25 **UNITED STATES DISTRICT COURT**
26 **CENTRAL DISTRICT OF CALIFORNIA**
27 **SOUTHERN DIVISION**
28

DIGITAL CBT LLC,

Plaintiff,

vs.

AT&T SERVICES, INC., et al.

Defendant.

Case No.: 2:12-cv-06421-CJC-JPR
**STIPULATION FOR ENTRY OF
FINAL JUDGMENT**

The Honorable Cormac J. Carney
United States District Court Judge

1 Plaintiff Digital CBT, LLC (“Digital CBT”) and Defendant AT&T Services,
2 Inc. (“AT&T”) (“collectively, the “Parties”), by and through their undersigned
3 counsel of record, jointly stipulate and request entry of judgment as follows:

4 WHEREAS on July 26, 2012, Digital CBT filed a Complaint against
5 Defendant AT&T Services, Inc. and Does 1-10 alleging infringement of U.S. Patent
6 No. 5,805,173 (the “‘173 Patent”). *See* [D.I. 1].

7 WHEREAS, on September 12, 2012, AT&T filed an Answer asserting
8 Affirmative Defenses including noninfringement and invalidity and Counterclaims
9 seeking: (1) declaratory judgment of non-infringement of the ‘173 Patent; and
10 (2) declaratory judgment of invalidity and/or unenforceability of the ‘173 Patent.
11 *See* [D.I. 12].

12 WHEREAS on May 13, 2013, AT&T filed a Motion for Summary Judgment
13 of Invalidity of Claims 1, 10, 11, and 29 of the ‘173 Patent. *See* [D.I. 23].

14 WHEREAS on October 14, 2013, AT&T filed a Motion for Claim
15 Construction and Partial Summary Judgment of (1) non-infringement of all claims
16 of the ‘173 Patent and (2) invalidity of Claims 1, 10, 11, and 29 of the ‘173 Patent.
17 *See* [D.I. 55].

18 WHEREAS, on October 14, 2013, Digital CBT filed a Motion for Summary
19 Judgment of Infringement of Claims 1 through 11, 14, 15, 22, 26, 29, 30, 32, and 34
20 of the ‘173 Patent. *See* [D.I. 58].

21 WHEREAS on December 3, 2013, the Court issued an Order (1) granting
22 AT&T’s motion for partial summary judgment of non-infringement as to all claims
23 of the ‘173 Patent and denying Digital CBT’s cross-motion for summary judgment
24 of infringement; and (2) holding that to the extent AT&T’s counterclaim seeks a
25 declaration of invalidity and unenforceability of the ‘173 Patent, it is moot. *See*
26 [D.I. 139].

1 WHEREAS on December 31, 2013, Digital CBT filed a precautionary notice
2 of appeal of the December 3, 2013 Order.

3 WHEREAS on January 14, 2014, AT&T filed a precautionary notice of
4 cross-appeal of the December 3, 2013 Order.

5 WHEREAS, despite the filing of precautionary notices of appeal, the parties
6 believe that a final judgment has not yet been entered in this case, because there has
7 been not yet been any judgment on multiple counterclaims and affirmative defenses
8 asserted by AT&T.

9 WHEREAS, the parties submit this stipulation in an attempt to position this
10 case for appeal, promote judicial efficiency, and avoid redundant or futile
11 proceedings.

12 WHEREAS, the parties agree that neither this stipulation nor judgment on
13 this stipulation waive or prejudice any rights of Digital CBT or AT&T to challenge
14 the December 3, 2013 Order on appeal or to appeal this judgment on any ground
15 relating to that Order.

16 THEREFORE, to facilitate an immediate appeal and conserve the resources
17 of the Court and the Parties, the Parties, by and through their respective counsel
18 hereby STIPULATE TO ENTRY OF FINAL JUDGMENT as follows:

19 1. The Court's December 3, 2013 Order resolves all claims asserted by
20 Digital CBT against AT&T in this Action. Based on that Order, the Parties agree to
21 entry of final judgment of non-infringement of each and every claim of the '173
22 Patent in favor of AT&T. *See* [D.I. 139].

23 2. Based on the Court's December 3, 2013 Order, the Parties agree to the
24 dismissal without prejudice of any counterclaims and affirmative defenses asserted
25 by AT&T as to which the Court has not granted summary judgment. In the event
26 Digital CBT's appeal results in a reversal of this Court's decision with respect to
27 noninfringement, these affirmative defenses and counterclaims shall be reinstated.
28

1 3. The Parties agree that the Court maintains jurisdiction to hear any
 2 motion or application brought by AT&T as the “prevailing party” in this Action for
 3 costs and/or attorneys’ fees pursuant to Local Rules 54-1, *et seq.* and any other
 4 applicable statute or rule.

5 4. The Parties agree that, by entering into this stipulation, neither waives
 6 nor otherwise forfeits any arguments that may otherwise be raised on appeal, cross-
 7 appeal, and/or remand from any such appeal or cross-appeal, including, without
 8 limitation, any rights to challenge the December 3, 2013 Order on appeal or to
 9 appeal from the stipulated judgment on any ground relating to that Order.

10 For the above-stated reasons and based on the above-stated stipulation, the
 11 Parties request that the Court enter Final Judgment in the form lodged with this
 12 stipulation.

13
 14 Dated: March 7, 2014

Respectfully submitted,

ONE LLP

17 /s/ William J. O’Brien
 18 William J. O’Brien
 19 Attorneys for Plaintiff and Counter-
 Defendant, DIGITAL CBT LLC

20 Dated: March 7, 2014

Respectfully submitted,

BAKER BOTTS L.L.P.

22 /s/ Timothy S. Durst
 23 Timothy S. Durst
 24 Attorney for Defendant and
 Counterclaimant, AT&T SERVICES, INC.

EXHIBIT B

Peter R. Afrasiabi (Bar No. 19336)
pafrasiabi@onellp.com
Nathaniel L. Dilger (Bar No. 196203)
ndilger@onellp.com
William J. O'Brien (Bar No. 99526)
wobrien@onellp.com
ONE LLP
4000 MacArthur Blvd.
East Tower, Suite 500
Newport Beach, California 92660
Telephone: (949) 502-2860
Facsimile: (949) 258-5081

Attorneys for Plaintiff and Counter-Defendant,
Digital CBT LLC

Timothy S. Durst (*admitted pro hac vice*)
Samir A. Bhavsar (*admitted pro hac vice*)
BAKER BOTTS L.L.P.
2001 Ross Avenue, Suite 800
Dallas, TX 75201-2980
Telephone: 214.953.6500
Facsimile: 214.953.6600

Attorneys for Defendant and Counterclaimant
AT&T SERVICES, INC.

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION**

DIGITAL CBT LLC,

Plaintiff,

vs.

AT&T SERVICES, INC., et al.

Defendant.

Case No.: 2:12-cv-06421-CJC-JPR
**[PROPOSED] STIPULATED FINAL
JUDGMENT**

The Honorable Cormac J. Carney
United States District Court Judge

1 Pursuant to the Court's December 3, 2013 Order Granting Defendant's
2 Motion for Partial Summary Judgment and Denying Plaintiff's Motion for
3 Summary Judgment (the "Order") and the Stipulation for Entry of Final Judgment
4 (the "Stipulation") between Plaintiff and Counter-Defendant, Digital CBT LLC
5 ("Digital CBT"), and Defendant and Counterclaimant, AT&T Services, Inc.
6 ("AT&T"), the Court directs entry of final judgment as follows:

7 1. The Court grants final judgment of non-infringement of each and
8 every claim of U.S. Patent No. 5,805,173 in favor of AT&T.

9 2. The Court dismisses without prejudice any counterclaims and
10 affirmative defenses raised by AT&T as to which the Court has not granted
11 summary judgment. These claims and defenses shall be reinstated in the event
12 that an appeal of this judgment results in a reversal of this Court's decision with
13 respect to noninfringement.

14 3. This is a final judgment that resolves all claims between all parties.

15 4. This judgment and the Stipulation are without any waiver of, or
16 prejudice to, Digital CBT or AT&T's rights to challenge the Order on appeal and
17 to appeal this judgment on any ground relating to the Order.

18 5. The Court retains jurisdiction to hear any motion or application for
19 costs and/or attorneys' fees pursuant to Local Rules 54-1, *et seq.* and any other
20 applicable statute or rule.

21
22 IT IS SO ORDERED.

23
24
25 Dated: _____

26 UNITED STATE DISTRICT JUDGE
27 CORMAC J. CARNEY
28